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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,293	10/06/2000	Takehiko Shigefuji	P19894	1800

7055 7590 12/31/2002

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EXAMINER

GOODMAN, CHARLES

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/680,293

Applicant(s)

SHIGEFUJI ET AL.

Examiner

Charles Goodman

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-19 and 21-38 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 and 23-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The Amendment filed on April 3, 2002 has been entered.
2. The Supplemental Amendment filed on April 3, 2002 has been entered.

***Election/Restrictions***

3. Applicant's election with traverse of Group I, Species X, in Paper No. 12 is acknowledged. The traversal is on the ground(s) that that basically there is overlapping subject matter and no burden upon the Examiner, and that the Species are not distinct due to, e.g. the manner in which the indicia is attached and Figs. 16 and 21 are flowcharts showing the operation of the apparatus illustrated in Figs. 10 and 17. This is not found persuasive because contrary to Applicant's assertions the number of different Groupings identified by the Examiner (and the Species) is a prima facie showing of serious burden upon the Examiner. While overlapping subject matter exists in the different Groups, each Group diverge in subject matter and a search for the particulars of one Group is not required for a search for the particulars in the other and vice versa. Regarding the noting of the Species, the Examiner will concede to the extent that Fig. 16 may show the operation of the "apparatus" illustrated in Fig. 10 and that Fig. 21 show the operation of the "apparatus" illustrated in Fig. 17. However, each apparatus are different, and therefore, they are subject to a Species restriction. Moreover, while the specifics of the various Species may not be explicitly claimed, they are at the very least claimed in a broad manner, and for purposes of compact prosecution, the Species requirement provides a basis for expediting prosecution. In any event, if an allowable

generic claim is found, then the Examiner will entertain rejoinder of the relevant non-elected claims.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 15-19 and 23-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group and Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 14, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anjo.

Anjo discloses the invention substantially as claimed except for a separate identification reader for the die. However, providing an separate reader is deemed to be an obvious addition to Anjo since the single medium reader as taught by Anjo is capable of reading media from both the punch and the die and since both a punch and die are of equal importance in Anjo due to the fact that in a punching operation, the punch and die work together to punch. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the method of Anjo with an additional reader, albeit for the die, for the reasons stated *supra*, and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding the “minimizing” and “efficiency” aspect in the claims, these are deemed to be obvious parameters in which the ordinarily skilled artisan takes into consideration when operating the punching processes.

### ***Response to Arguments***

7. Applicant's arguments filed April 3, 2002 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that the claimed invention is not obvious over Anjo due to the allegation that Anjo does not disclose or suggest “minimizing” or “efficiency” as claimed, this argument is traversed. It is the Examiner's opinion that although Anjo may not explicitly include these considerations, these aspects of programming are inherent since one of ordinary skill in the art typically programs the punching process to minimize down time, inter alia, as well as maximize efficiency of any machining operation, especially a punching operation.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

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In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.



**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

cg   
December 30, 2002

**HARLES GOODM**  
**PRIMARY EXAMI**